

REMARKS

Applicants respectfully request reconsideration and allowance in view of the foregoing amendments and following remarks. In the Office Action, mailed September 8, 2006, at least as enumerated in the Office Action Summary, the Examiner rejected claims 1, 3-14, 16-41, 43-70, 72-82, 84-121 and 123-150. By this response, claims 1, 3-9, 11, 14, 16-18, 22-26, 28, 43-46, 49, 51-53, 64-65, 70, 72-78, 80, 82, 84, 89-93, 95-96, 100, 107, 110-113, 115-117, 119-120, 123, 129, 132, 135-137, 139-140 and 142-147 have been amended; claims 48 and 109 have been canceled; and no claims have been added. Following entry of this response, claims 1, 3-14, 16-41, 43-47, 49-55, 59-70, 72-82, 84-108, 110-121 and 123-150 will be pending in the application.

Missing Claim Rejections

In the Office Action Summary, the Examiner allegedly rejected claims 1, 3-14, 16-41, 43-70, 72-82, 84-121 and 123-150. However, within the Office Action itself, there is no rejection detail provided for certain of these claims. Thus, Applicants assert that the rejection of these claims is improper and should be withdrawn.

Specifically, for claim 97, there is no mention of this claim anywhere within the Detailed Action section of the Office Action. Claims 134 & 135 are included in the initial sentence of paragraph 4 of the Detailed Action section of the Office Action, and there is no rejection detail provided under paragraph 4 for these claims. However, claim 135 is mentioned again, and rejection detail is provided, under paragraph 7 of the Detail Action section of the Office Action. Thus, claim 134 has no rejection detail provided for it in the Office Action. Finally, claims 141 & 142 are included in the initial sentence of paragraph 7 of the Detailed Action section of the Office Action, and there is no rejection detail provided under paragraph 7 for these claims. Note also, that the Summary includes claims 56-58, which were cancelled in a prior office action.

Therefore, Applicants respectfully request withdrawal of the rejections of claims 97, 134 and 141-142.

Claim Rejections under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 3-14, 20-21, 46-55, 59-70, 72-82, 87-96, 100-110, 113-121 and 123-135 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,924,013 to Guido, et al. (hereinafter “Guido”) in view of U.S. Patent No. 5,818,512 to W. Fuller (hereinafter “W. Fuller”) and further in view of U.S. Patent No. 6,711,622 to M. Fuller, et al. (hereinafter “M. Fuller”). Also in the Office Action, the Examiner rejected claims 16-19, 44, 84-86 and 111 under 35 U.S.C. §103(a) as allegedly being unpatentable over Guido, in view of W. Fuller and M. Fuller, and further in view of U.S. Patent No. 6,005,938 to Banker, et al. (hereinafter “Banker”). Also in the Office Action, the Examiner rejected claims 45 and 112 under 35 U.S.C. §103(a) as allegedly being unpatentable over Guido, in view of W. Fuller, M. Fuller and Banker, and further in view of International Publication No. WO/1997/006637 to Gulla (hereinafter “Gulla”). Also in the Office Action, the Examiner rejected claims 22-41 and 136-150 under 35 U.S.C. §103(a) as allegedly being unpatentable over W. Fuller, in view of Guido and Banker. Applicants respectfully traverse the rejections of claims 1, 3-14, 16-18, 20-41 44-55, 59-70, 72-82, 84-96, 100-121 and 123-150, and note for subsequent reference the following standards for a proper §103(a) rejection.

A §103(a), or obviousness, rejection is proper only when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.” 35 U.S.C. §103(a). The *en banc* Federal Circuit has held that “structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a prima facie case of obviousness.” *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1901 (CAFC 1990). The underlying inquiries into the validity of an obviousness rejection are: “(1) the scope and content of the [analogous] prior art; (2) the level of ordinary skill in the [analogous] prior art; (3) the differences between the claimed invention and the [analogous] prior art; and (4) objective evidence of nonobviousness.” *In re Dembiczak*, 175 F.3d 994, 998, (Fed. Cir. 1999).

The examiner must determine what is “analogous prior art” for the purpose of making a proper §103(a) rejection of the subject matter at issue. While Patent Office classification of references and the cross-references in the official search notes of the class definitions provide some evidence (or not) of prior art analogy, the court has found “the similarities and differences in structure and function of the inventions to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973). For example, in *Wang Laboratories*, the patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers and the prior art was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced in large industrial machine controllers. Thus the court held that the reference was nonanalogous prior art notwithstanding that it generally related to memories. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993); *see*, MPEP 2141.01(a).

When applying a §103(a) rejection, the Examiner must adhere to the following tenets of patent law: (1) the claimed invention must be considered as a whole; (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (4) reasonable expectation of success is the standard with which obviousness is determined. *See, Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986); and MPEP 2141.

Further, discovering the source and/or cause of a problem is part of the “as a whole” inquiry for a proper §103(a) rejection. “[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” *In re Spinnoble*, 405 F.2d 578, 585 (CCPA 1969). *See*, MPEP 2141.02.

The Examiner must make out a *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); see, MPEP § 2142. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Likewise, if the proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Second, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); see, MPEP § 2142.

Third, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references, when combined). *In re Royka*, 490 F.2d 981 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); see, MPEP § 2143.03.

Additionally, with hindsight, a claim of obviousness can be an easy one to make. Many inventions seem obvious with the clarity of 20-20 hindsight. However, a hindsight basis for obviousness is inappropriate and cannot sustain a *prima facie* case of obviousness. The content of the prior art used for a §103(a) rejection should be determined at the time the invention was made to avoid impermissible hindsight. The Federal Circuit has held:

It is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).
See, MPEP 2141.01.

For at least the reasons stated below, taking into account the standards for a proper obviousness-type rejection presented above, Applicants assert that the Examiner's various combinations of Guido, W. Fuller, M. Fuller, Banker and Gulla fail to describe or suggest the subject matter as a whole of Applicants' claims and, therefore, that Applicants' rejected claims 1, 3-14, 16-41, 43-70, 72-82, 84-96, 98-121, 123-134, 136-140 and 143-150 are patentably distinct from Guido, W. Fuller, M. Fuller, Banker and Gulla.

Independent Claims 1 and 70

Applicants' independent claims 1 and 70, as amended, recite an apparatus and method, respectively, for the distribution of image, of either still or motion type, and audio information to a plurality of viewing locations that includes:

(means for) independently receiving, at each of the plurality of viewing locations, at least one compressed and encrypted image file, which is associated with at least one corresponding image program, and a plurality of compressed and encrypted audio files, which are associated with a plurality of corresponding audio programs, for presentation at at least one preselected later time, wherein

the at least one compressed and encrypted image file and the plurality of compressed and encrypted audio files **are all associable using at least one identifier for each of the at least one compressed and encrypted image file and the plurality of compressed and encrypted audio files;**

(means for) independently storing in a storage system at each of the plurality of viewing locations the compressed and encrypted image and audio files;

(means for) independently distributing the compressed and encrypted image and audio files from the storage system to at least one auditorium at each of the plurality of viewing locations, **based at least in part on the at least one identifier;**

(means for) independently receiving the compressed and encrypted image and audio files in each auditorium;

(means for) independently decrypting the compressed and encrypted image and audio files in each auditorium, resulting in at least one compressed image file and a plurality of compressed audio files;

(means for) independently decompressing the compressed image and audio files in each auditorium, resulting in the at least one corresponding image program and the plurality of corresponding audio programs;

at least one projection system in each auditorium for receiving the at least one corresponding image program and presenting the at least one corresponding image program at the at least one preselected later time; and

at least one sound system in each auditorium for receiving the plurality of corresponding audio programs and selectively playing at least one of the plurality of corresponding audio programs with the presented at least one corresponding image program.

In asserting obviousness of independent claims 1 and 70, the Examiner refers to various sections of Guido, W. Fuller and M. Fuller. However, as amended, Applicants contend that no combination of the cited art renders claims 1 and 70 obvious for at least the following reason.

Applicants have amended independent claims 1 and 70 to include, *inter alia*, additional limitations relating to the “at least one identifier.” In the Office Action, the Examiner, in rejecting the “identifier” limitation of dependent claim 7, assumes that M. Fuller “necessarily include[s] an identifier to synchronize the programs.” However, this assumption is not supported by the Examiner, either in M. Fuller or anywhere else. If the Examiner is making a claim of Inherency, then the Examiner must support this claim using M. Fuller.

Additionally, even if the Examiner were able to make a proper inherency rejection of the “identifier” limitation of former dependent claim 7, Applicants’ new “at least one identifier” limitation of amended independent claims 1 and 70 is substantially different than former dependent claim 7. Applicants assert that this new, “at least one identifier” limitation is nowhere in the art of record.

Applicants’ “at least one identifier” limitation in amended independent claims 1 and 70 is not necessarily a synchronization queue between a particular video file and its associated audio file. Rather, it is used, *inter alia*, for identifying which compressed and encrypted video file belongs to which plurality of compressed and encrypted audio files. This is not at all similar to what the Examiner refers to as “an identifier to synchronize the programs” of M. Fuller.

Further, Applicants have amended independent claims 1 and 70 to require the distribution among a plurality of viewing locations. This also, in combination with the totality of the limitations is nowhere disclosed or suggested in the art of record.

In summary, for at least the reasons presented above, the various combinations of Guido, W. Fuller and M. Fuller do not disclose or suggest the requirements of amended independent claims 1 and 70. Accordingly, Applicants respectfully submit that amended independent claims 1 and 70 are allowable over the art of record.

Dependent Claims 3-8, 14, 16-21, 43-47, 49-55, 59-61, 72-77, 82, 84-88, 110-121 and 123-126

Dependent claims 3-8, 14, 16-21, 43-47, 49-55, 59-61, 72-77, 82, 84-88, 110-121 and 123-126 ultimately depend from one of amended independent claims 1 or 70. The allowability of dependent claims 3-8, 14, 16-21, 43-47, 49-55, 59-61, 72-77, 82, 84-88, 110-121 and 123-126 thus follows from the allowability of amended independent claims 1 and 70. Therefore, for at least these reasons, dependent claims 3-8, 14, 16-21, 43-47, 49-55, 59-61, 72-77, 82, 84-88, 110-121 and 123-126 are allowable over the art of record.

Independent Claims 136 and 143

For at least the reasons stated above in relation to the allowability of amended independent claims 1 and 70, Applicants assert that one of ordinary skill in the art would not have considered Applicants' amended independent claims 136 and 143 obvious at the time of Applicants' invention and, therefore, that Applicants' rejected independent claims 136 and 143 are allowable over the art of record.

Dependent Claims 9-13, 22-41, 62-69, 78-81, 89-108, 127-435, 137-142 and 144-150

Dependent claims 9-13, 22-41, 62-69, 78-81, 89-108, 127-435, 137-142 and 144-150 ultimately depend from one of amended independent claims 136 or 143. The allowability of dependent claims 9-13, 22-41, 62-69, 78-81, 89-108, 127-435, 137-142 and 144-150 thus follows from the allowability of amended independent claims 136 and 143. Therefore, for at

least these reasons, dependent claims 9-13, 22-41, 62-69, 78-81, 89-108, 127-435, 137-142 and 144-150 are allowable over the art of record.

CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that this application is in condition for allowance and a Notice to that effect is earnestly solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Charge Statement: For this application, the Commissioner is hereby authorized to charge any required fees or credit any overpayment to Deposit Account 17-0026.

Respectfully submitted,
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Date: March 8, 2007

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